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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,348	04/22/2004	Birgit C. Hofmann	041194-0103	6586

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3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

LOCKER, HOWARD J

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/829348

Applicant(s)

Hofmann

Examiner

Howard I. Locker

Group Art Unit

1661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on April 22, 2004 and July 16, 2004
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ ~~Claim(s)~~ The claim is ~~is/are~~ pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ ~~Claim(s)~~ The claim is ~~is/are~~ rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

Office Action Summary

1. The following is a quotation of section (a) of 37 CFR 1.163:

"(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered."

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor in carrying out his invention."

In plant applications filed under 36 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

"No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

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As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known varieties and antecedents.

A. As regards Genus/species designation of the instant plant on page 1 of the specification, "New Guinea" is not a portion of the Genus designation, and should not be indicated as such as is presently the case. Similarly, the designation "W. Bull" does not appear to properly be a part of the species designation. The proper Genus/species designation is "*Impatiens hawkeri*", and should be uniformly and consistently set forth as such.

B. Contrary to what is set forth at page 3 of the specification, the instant cultivar does not appear to be distinguished from 'Fisnics Red' as regards flower color in the manner alleged therein. Per the specification of United States Plant Patent Number 13,226, the bloom coloration thereof appears to be darker red than that of the instant cultivar, with the instant cultivar also not exhibiting the "slight scarlet hue" alleged, either per the submitted photographic illustrations or per the color designations set forth in the instant specification.

C. Contrary to what is set forth at page 3 of the specification, the instant cultivar does not appear to be distinguished from 'Fisimp 171' in the manner alleged. More particularly, the instant plant looks to be shorter rather than taller in height than the comparative cultivar. Additionally, the "slightly scarlet hue" alleged is objectionable for the reasons set forth in "B" above as properly characterizing the flower coloration of the instant plant, and rather than being cherry red, the flower color of the comparative cultivar looks to be more reddish-purple than that of the instant plant as well as darker in tone.

D. At line 10 of page 4, "braches" appears.

E. Relative to foliage coloration, the leaf undersurface should also be accounted for with reference to the employed Color Chart.

F. The information presented at lines 6-8 of page 5 is confusing, as there are separate and different color designations set forth for the vein coloration.

G. Relative to the information presented at line 16 of page 5, such should be reviewed for accuracy per se (should this read "per branch" instead?), and clarified so as to set forth whether flowers appear at every node or just at the terminal node.

H. Lastingness of the individual bloom should be accounted for in some manner in the specification, as should characteristic fragrance (if present).

I. Relative to spur coloration as set forth at line 6 of page 6, the RHS color designation set forth would appear better characterized as "red" rather than "deep pink".

J. If the plant has been observed to have produced seed/fruit, such should be accounted for in the specification. If such has not been observed to be a characteristic

of the plant, this also should be set forth in the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

K. If additional information is now available relative to characteristic and observed disease resistance or susceptibility, such should likewise be incorporated into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

L. To the extent that "*New Guinea Impatiens*" as italicized in the written disclosure (including in the abstract and the claim) is intended to somehow convey Genus designation of the instant plant, such is improper, and should be rewritten in un-italicized form.

Relative to this issue, it is noted that in the "Request for Corrected Filing Receipt" received July 16, 2004, it is stated that "The species name of the plant is ***New Guinea Impatiens***." Such obviously connotes the market or common name of the plant, rather than the species designation of same, which is "*hawker*".

Correction and/or clarification relative to A-L as set forth above is necessary responsive to this Office action. Additionally, applicant should carefully review the instant disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant, for the reasons advanced in paragraph 1 above.

3. The two United States Plant Patents referenced in paragraph 1 above (and in applicant's specification as the closest comparative cultivars) are being formally made of record by the Examiner.

4. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdprac.htm>

5. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

6. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew Wang, can be reached at 571-272-0811.


Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600.

### **TELECOPY/FACSIMILE TRANSMISSION**

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is: 703-872-9306. The new central fax number for official correspondence is 571-273-8300.

Howard J. Locker/hjl

June 09, 2005

  
HOWARD J. LOCKER  
EXAMINER  
GROUP ART UNIT 1661